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PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number (Optional)	
I hereby certify that this correspondence is being deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to "Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450" [37 CFR 1.8(a)]		A-7259 (191910-1870)	
on May 30, 2006	Application Number 09/896,231	Filed June 29, 2001	
Signature	First Named Inventor Rodriguez, et al	Art Unit 2617	Examiner Laye, Jade O.
Typed or printed name Brooke French			
Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.			
This request is being filed with a notice of appeal.			
The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.			
I am the			
<input type="checkbox"/> applicant/inventor.	Signature		Benjamin A. Balser
<input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)	Typed or printed name		(770) 933-9500
<input type="checkbox"/> attorney or agent of record. Registration number	Telephone number		May 30, 2006
<input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34	Date		
NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.			
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This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In Re Application of:

Rodriguez, et al

Serial No.: 09/896,231

Filed: June 29, 2001

Confirmation No.: 9416

Group Art Unit: 2617

Examiner: Laye, Jade O.

Docket No A-7259 (191910-1870)

For: Bandwidth Allocation and Pricing System for Download Media Content

REMARKS IN SUPPORT OF
PRE-APPEAL BRIEF CONFERENCE

Mail Stop AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

Applicants submit the following remarks in support of a Request for a Pre-Appeal Brief

Conference.

Serial No.: 09/752,307

Art Unit: 2685

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REMARKS

I. Status

Claims 1-4, 19, 20, 22, 23, 24, 62, 63, 64, 65, 67-69, 72, and 74 are rejected under 35 U.S.C. § 102(e) as being allegedly anticipated by Rodriguez *et al.* Claim 5 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hooper *et al.* Claim 6 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Greenwood *et al.* Claim 7-18, 21, 26-50 and 53-61 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hassell *et al.* and further in view of Seazholtz *et al.* Claim 25 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hassell in view of Seazholtz, in view of Kitsukawa *et al.* Claims 51 and 52 are rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Hassell in view of Seazholtz, in view of Okamoto *et al.* Claim 66 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Wahl. Claim 70 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad. Claim 71 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Okamoto *et al.* Claim 73 is rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Haddad in view of Seazholtz. Applicant traverses these rejections and respectfully submits that the rejections of record are clearly not proper.

II. Rejection of Independent Claims 1 and 63 and Rodriguez

Specifically, Applicant submits that the following clear legal deficiency exists in the rejection. Applicant respectfully submits that a claimed element, specifically among others, “a first processor configured with the first memory to download recordable media content at one of a plurality of various download times for purchase of the recordable media content” is not taught by the references of record either singularly or in combination. The Office Action alleges that “Rodriguez discloses a system comprising a memory, which is capable of downloading purchasable recordable media at different times ... (Pars. 7, 36, 38, 39, 47, 48, 52, 53, 61, and 62).” Applicant respectfully submits that Rodriguez **fails** to teach a processor configured to

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download recordable media content as claimed. The media content of *Rodriguez* is video-on-demand. The video is not recordable. The Advisory Action alleges that, since video can be recorded, all video is recordable content. However, in the system taught by *Rodriguez*, the system **cannot** record the video. None of the cited paragraphs disclose recording video. The recording of video is not taught by *Rodriguez*. Therefore, Applicant challenges the Examiner's statement as clear error. Applicant respectfully submits that for at least this reason, the rejections of claims 1 and 63 are improper and should be withdrawn.

III. Rejection of Dependent Claims 15 -18

Applicant submits that the following clear legal deficiency exists in the rejection. Applicant respectfully submits that a claimed element, specifically, among others, "using reallocated excess on-demand infrastructure capacity" does not appear to have received an examination in the Final Office Action. In the rejection of claims 15-18, the Office Action references language present before the latest amendment, language that is no longer present in the claims. The Advisory Action asserts that "the limitation was addressed on page 8 of the action." See *Advisory Action*, page 2. However, even if similar language to the language in question in claims 15-18 was examined in claim 5, claim 5 does not include all the limitations of claims 15-18. In fact, claim 5 is rejected under a different combination of references than the references under which claims 15-18 are rejected. Claim 5 is rejected under a combination of Haddad and Hooper, and claims 15-18 are rejected under a combination of Haddad, Hassell, and Seazholtz.

The Advisory Action asserts that "[t]he Examiner did overlook and fail to delete the portions of the action that discuss the deleted claim language. This was [allegedly] a simple oversight." The fact that this may have been an oversight does not offer Applicant an opportunity to address the rejection in any meaningful way. For at least this reason, the finality of the latest Office Action should be withdrawn and a new Office Action, should one be necessary, should be entered.

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IV. Rejection of Independent Claims 1 and 63 and Haddad

Applicant submits that the following clear legal deficiency exists in the rejection. Applicant respectfully submits that a claimed element, specifically among others, "using reallocated excess on-demand infrastructure capacity" is not disclosed by the references of record either singularly or in combination. The Office Action states that "Haddad further teaches the system is capable of distributing the multimedia data at various times, such as off-peak hours, to more efficiently utilize the system hardware ... (Col. 2, Ln 34-Col. 3, Ln. 5)."

This section does **not** teach reallocating excess on-demand infrastructure capacity as alleged in the Office Action. **Reallocation** of capacity is not mentioned or even alluded to; reallocating **excess on-demand infrastructure** capacity is nowhere to be found in the reference. The Office Action appears to attempt to read claim terms such as "excess on-demand infrastructure" out of the claims. Even if this section teaches that the subscriber may decide when to download the content to meet his or her needs, it certainly does not teach the reallocation of excess on-demand infrastructure capacity. Therefore, Applicant challenges the Examiner's statement as clear error. Applicant respectfully submits that for at least this reason, the rejections of claims 1 and 63 are improper and should be withdrawn.

V. Findings of Official Notice Regarding Claims 7, 12, 17, 18, 21, 40, 45, 47, 49, and 61

The Office Action further takes Official Notice that some features in the claims are well-known in the art. As noted by the court in *In re Ahlert*, 424 F.2d 1088, 1091 (CCPA 1970), the notice of facts beyond the record which may be taken by the examiner must be "capable of such instant and unquestionable demonstration as to defy dispute." This is an extremely high level to be reached. Particularly in the context of the various claimed combinations, the subject matter alleged to be well-known is too complex for one of ordinary skill in the art to consider it to be well-known to the point that no additional evidence is needed. If Applicant adequately traverses the examiner's assertion of Official Notice, the Examiner must provide documentary evidence in the next Office Action if the rejection is to be maintained. Applicant submits that the Examiner's assertion was adequately traversed. In turn, Examiner submitted single patents as documentary evidence that features in claims 7, 12, 17, 18, 21, 40, 45, 47, 49, and 61 are well-known.

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Applicant respectfully submits that a single patent is not sufficient evidence in and of itself to support a conclusion that a feature is well-known. If the converse were true, every element found in a patent reference could be considered to be well-known. Instead, Applicant submits that the fact that the feature was considered patentable by the U.S.P.T.O is evidence that the feature is not well-known. In fact, if the mere presence of a feature in a patent leads to the conclusion that the feature is well-known, a claim would almost never be found to be allowable. Applicant further asserts that proper patent examining procedure would use the cited references in a rejection under 35 U.S.C. §103 should one be deemed warranted.


Additionally, an assertion that an element, by itself, in a vacuum, is well-known is insufficient to form a rejection. To form the basis of a rejection, the element must be well-known in combination with each and every element of the claim. To hold otherwise would abolish the combination of elements concept. As the cited features have not been shown capable of such instant and unquestionable demonstration as to deny dispute, the finding that the features are "well-known" is improper and the claims should be allowed.

CONCLUSION

For at least the reasons set forth above, Applicant respectfully submits that all objections and/or rejections have been traversed, rendered moot, and/or accommodated, and that the now pending claims 1-74 are in condition for allowance. Favorable reconsideration and allowance of the present application and all pending claims are hereby courteously requested.

Respectfully submitted,

**THOMAS, KAYDEN, HORSTEMEYER
& RISLEY, L.L.P.**

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